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| APPLICATION NO.                     | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/605,290                          | 06/28/2000  | Howard Stein         | PMS-265915 HS-1     | 5958             |
| 27498                               | 7590        | 02/06/2006           | EXAMINER            |                  |
| PILLSBURY WINTHROP SHAW PITTMAN LLP |             |                      | COLIN, CARL G       |                  |
| P.O. BOX 10500                      |             |                      | ART UNIT            |                  |
| MCLEAN, VA 22102                    |             |                      | PAPER NUMBER        |                  |
|                                     |             |                      | 2136                |                  |
| DATE MAILED: 02/06/2006             |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/605,290 | <b>Applicant(s)</b><br>STEIN, HOWARD |  |
|                              | <b>Examiner</b><br>Carl Colin        | <b>Art Unit</b><br>2136              |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,6,8,10-21,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1/24/05</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/3/2005 has been entered.

### ***Response to Arguments***

2. In response to communications filed on 10/3/2005, applicant amends claims 1, 11, and 16. The following claims 1-3, 6, 8, and 10-21, 23 and 24 are presented for examination.

2.1 With respect to the amendments to the claims, filed on 10/3/2005 the 112<sup>th</sup> rejection to claims 11 and 16 have been withdrawn.

2.2 Applicant's remarks, filed on 4/4/05 and 10/3/2005, with respect to the rejection of claims 1, 11, and 16 have been fully considered but they are moot in view of a new ground of rejection.

### ***Claim Rejections - 35 USC § 102***

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.1 **Claims 1-3, 11-13, 16-18, and 21** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,718,471 to **Kashima**.

3.2 **As per claim 1, Kashima** discloses an encrypting security device comprising a security photograph incorporating a multiplicity of picture elements, the security photograph having an image of an object, the object having a size, the image having a size that is greater than the size of the object, for example (see column 9, lines 25-36 and column 7, lines 1-23); an image password setting module that executes setting processing of various images that become the image password that meets the recitation of a scanner that outputs a digital representation of the security photograph, for example (see column 8, lines 57 through column 9, line 36); and a software program that converts the digital representation of the security photograph into an encrypted passkey that is stored within the encrypting security device and further automatically matches the encrypted passkey to the digital representation of the security photograph for

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allowing access to an associated apparatus, for example (see column 9, lines 37-61 and column 10, lines 15-18, 45-52, and column 20, lines 33-36).

**As per claim 2, Kaplan et al.** discloses the limitation of wherein the associated apparatus is a computer or computer program (see column 20, lines 33-36).

**As per claim 3, Kashima** discloses the limitation of wherein the associated apparatus is selected from a group including a vehicle, a safe, a cash register, a locking system of a building, and an alarm system of a building (see column 20, lines 33-36).

**As per claims 11 and 16, Kashima** discloses a security system that controls access to a secured element the security system comprising: a medium having an image of an object, the medium having an authorized user, the authorized user having a face, the image being free of the face of the authorized user (column 8, line 64 through column 9, line 37 and column 6, line 64 through column 7, line 22); an image password setting module that executes setting processing of various images that become the image password that meets the recitation of a scanner that scans the medium to generate a digital representation of the image (see column 8, lines 57 through column 9, line 36); and a processor (input judgment module) connected to the scanner that grants access to the secured element when the digital representation satisfies an access criteria and denies access to the secured element when the digital representation fails to satisfy the access criteria (column 19, lines 33-67).

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As per claims 12-13 and 17-18, **Kashima** discloses the limitation of wherein the processor grants access to the secured element when the digital representation matches a stored value, and denies access to the secured element when the digital representation does not match the store value (column 19, lines 33-67).

**Claim 21** recites similar limitations as found in claims 1 and 11 above. Therefore, these claims are rejected on the same rationale as the rejection of claims 1 and 11.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 6, 8, 10, 14-15, 19-20, and 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,718,471 to **Kashima** in view of US Patent 5,932,119 to **Kaplan et al.**

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4.2 As per claims 6, 10, 14-15, 19-20, and 23-24, **Kashima** discloses varying the image and deepening the structure of the image for further improving the strength of the security so that to make it very difficult to a third party to appropriate the electronic information to arrive at the correct password (column 6, lines 7-67). **Kashima** does not explicitly teach the security photograph is an enlargement of the center of a gemstone. However, **Kaplan et al.** in an analogous art teaches an imaging and marking system for verifying an image of an object such as a gemstone to verify that the object is authentic including marking portions of the object which is self-authenticating and further discloses that the image of the object may be used as authentication (column 3, line 18 through column 4, line 10 and column 7, lines 1-10; column 25, lines 35-60); further discloses a photograph with multiplicity of elements (see column 4, lines 1-12) wherein the security photograph is an enlargement of the center of a gemstone because each stone has varying characteristics that make each stone essentially unique (see column 12, lines 36-47 and column 15 lines 60 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the photograph of **Kashima** with a photograph of an enlarged image of multiplicity of picture elements such as an enlargement of the center of a gemstone because each stone has varying characteristics that make each stone essentially unique as taught by **Kaplan et al.** (column 8, lines 1-15). This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Kaplan et al.** so as to benefit from varying characteristics, details, and uniqueness of the image of the stone to make it difficult to a third party to appropriate the electronic information to arrive at the correct password as suggested by **Kashima** (see **Kashima**, column 6, lines 7-67).

**As per claim 8**, claim 8 recites the same inventive concept as claim 1 except for incorporating the claimed device of claim 1 into a method and. Therefore, claims 8 and 11 are rejected on the same rationale as the rejection of claim 1.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses many of the claimed features with respect to authenticating an image of plurality of elements to grant or deny access to an associated apparatus.

US Patents: 4,811,408 Goldman; 5,801,856 Moghadam et al; 5,430,277 Ohno et al; 6,397,334 Chainer et al.

5.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR



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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*ce*

Carl Colin

Patent Examiner

January 31, 2006

*CC*

*Primary Examiner*

*AV2131*

*2/1/06*